



Docket No. 310048-650

Applicant: Norman Yamamoto. Examiner: M. Henderson
 Serial No. 09/921,934 Group Art Unit: 3722
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 Title: FLEX-VIEW COVER BOUND DOCUMENT ASSEMBLY

CERTIFICATE UNDER 37 CFR 1.8

I hereby certify that this correspondence and identified enclosures are being deposited with the United States Postal Service, first class mail, postage prepaid, under 37 C.F.R. 1.8 on the date indicated, and is addressed to the Commissioner for Patents, BOX: Non-Fee Amendment, Washington, D.C. 20231 on March 5, 2003

Justina S. Townsend
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BOX: Non-Fee Amendment
 Commissioner for Patents
 Washington, D.C. 20231

DECLARATION OF JAY SATO

I, JAY SATO, hereby declare as follows:

1. I have been employed by Avery Dennison Corporation, the assignee of the above-identified patent application for about two years. I am a Senior Product Development Engineer. I am a graduate with a B.S. Degree in Mechanical Engineering from Washington University of St. Louis, Missouri.
2. I have reviewed the communication from the U.S. Patent Office dated January 16, 2003, and the references cited in that communication, specifically including U.S. Patent No. 6,206,602 to Yamamoto et al. (Yamamoto '602), U.S. Patent No. 6,364,559 to Brown et al. (Brown '559), U.S. Patent No. 5,590,911 to Wilson (Wilson '911) and U.S. Patent No. 4,991,767 to Wyant (Wyant '676).
3. It is noted that the present invention involves a transparent pocket secured on only two sides to the inside of the semi-flexible binder front cover. The preferred embodiment, which Avery is commercializing and which is being claimed, is shown in FIG. 4 of the drawings. The pocket extends beyond the framed open area of the transparent cover, or is at least coextensive with the open area.

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4. The claimed invention has shown commercial success. For example, the claimed invention was launched late last year (2002), however, sales of the transparent binder cover with the inner pocket were still high at 20,000 units, or \$140,000 in sales. To date, expectations and customer interests remain high and increased sales over the year 2002 are expected.

5. The rejections are based primarily on the Yamamoto '602 patent and further in view of Brown '559, Wilson '911 and Wyant '676 patents. Yamamoto '602 discloses a large size transparent pocket secured on three sides, while the upper edge of the plastic sheet is left open, to permit the insertion of visual display material (column 2, lines 60-67; FIG. 1 & 2). On a practical matter, it is difficult to insert visual display material, for example, an 8 1/2 x 11-paper size insert, via one opening. In contrast, the claimed invention claims a large size pocket secured on only two sides, thus allowing the top and right hand side to be open. Insertion of visual display material then is easy because the two open sides allow greater and easier access to the framed open area, while still holding the visual material insert firmly against the binder cover.

6. The combination of Yamamoto '602 with the secondary reference(s) is not proper because the prior art only discloses smaller-sized pockets for the purpose of holding various loose-leaf papers (see FIG. 5 of Brown '559 patent). In particular, in Brown '559, the pocket of FIG. 5 is only a partial pocket that is secured on two sides to the edges of the binder cover, and only covers about half of the area of the binder cover. The purpose of the Brown '559 partial-pocket is stated to be to hold business cards in the slits in the pocket. Further, a standard size 8 1/2 x 11 sheet of paper will not be held firmly in place against the cover by the Brown '559 pocket because the pocket leaves the top part and the right hand side of the paper free or loose. The free edges of any insert could easily be folded, crumpled or torn. Whereas, in the claimed invention, the pocket is large and extends to the edge of the binder cover or at least coextensive with the overlying open area, such that the paper insert(s) are firmly held in place against the cover throughout the area of the insert and does not have unsecured or loose edges. Accordingly, the pocket of the claimed invention and that of the Brown '559 are different first in dimension(s) and secondly they are different in purpose.

7. It is further noted that the inserts are formatted so that when the inserts are mounted in the pocket with the pocket fully enclosing the insert, the visual part of the insert is properly centered or located in the assembly to show the desired image within the frame on the binder cover. Now, regarding the Brown et al. patent, the pocket 45 is said to be of "polypropylene film with slits 53 shaped to receive business cards". Any loose leaf papers which

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might be randomly hold within pocket 45 would not be accurately positioned relative to the cover. This is in contrast to the present invention in which the pockets extend over the cover frame area, so that the pockets accurately position the formatted insert to be visible through the cover frame.

8. Further, even if the combination of references were proper (which is not appropriate), as mentioned previously, the prior art does not disclose pockets that are of the same or similar dimensions as the pocket of the claimed invention. Again, the claimed invention recites a large pocket that is secured on only two sides and is at least coextensive with the framed open area or extends to the edges of the cover to both locate the visual inserts for viewing through the cover and to hold the inserts firmly in place. In contrast, the prior art references teach a large size pocket secured on three sides or a partial-pocket with much smaller dimensions. The partial-pockets in the prior art are for a different purpose and do not firmly hold the entire area of an 8 1/2 x 11 or A4 paper in place.

9. Thus, in the first place the combination of the prior art is not proper because the prior art disclose pockets that are secured on three sides leaving only one side open. A pocket with only one opening makes it difficult to insert visual material through. In the second place, the prior art describes pockets with a different purpose and function than the claimed invention. For example, in Brown '559, the partial-pockets are to hold business cards or possibly loose-leaf papers. In Wyant '767 the small pockets are to hold small size photographs or visual materials.

10. Accordingly, the complete binder of the claimed invention is clearly not suggested by these references, and the claimed invention appears to be satisfying a basic and long felt need for accurately holding visual inserts firmly in place to readily form a personalized cover binder. The differences from the prior art may be summarized as follows:

- (a) The Yamamoto prior art binder has pockets secured on three sides, and is difficult to use.
- (b) The Brown prior art binder has only a partial pocket for mounting business cards.
- (c) The claimed full size pocket positions the formatted visual insert accurately located within the cover frame.
- (d) The claimed full size pocket holds the visual insert against the cover across the entire area within the frame.

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I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent application issuing thereon.

Respectfully submitted,


Jay Sato

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